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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/659,840
Filing Date: September 11, 2003
Appellant(s): GREESON ET AL.

ROBERT BECKER
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/15/08 appealing from the Office action mailed 6/0807.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

A. The rejection under 35 USC 112 is limited to the non-systemic criticality.

Claims 1, 2, 4-14 & 16-21 STAND rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is retained as to the non-systemic criticality, As originally presented in the office action of 11/25/06.

B. Claims 1,2,4,5,& 9 stand rejected under 35 U.S.C. 102(b) as being anticipated by WALDSTEIN- 4176076

Claim 10 is removed from rejection per appellant's arguments.

C. Claims 1,2,4,5,7,8 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over MALLIS et al 2988473.

This rejection stands unchanged.

D. Claims 1-2,5, 7-9 & 11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over COFFEE et al 4316914 as explained by centistokes to SUS conversion table (Velcon 2003).

Claim 10 is removed from rejection per appellant's argument.

E. The rejection of claims 1,5,9,10,12,14,16, & 17 as anticipated under 35 U.S.C. 102(b) by LEWER et al is withdrawn in view of appellant's arguments.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4176076	WALDSTEIN	11-1979
2988473	MALLIS et al	6-1961
4316914	COFFEE et al	2-1982

VELCON; CENTISTOKES TO SAYBOLT UNIVERSAL SECONDS
CONVERSION, 2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

A. Claim Rejections - 35 USC § 112

Claims 1, 2, 4-14 & 16-21 STAND rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is retained as to the non-systemic criticality, As originally presented in the office action of 11/30/06.

Appellant argued the criticality of the invention is providing a mixture which remains on the surface & acts non-systemically. However, the claims are to pesticide ADAPTED TO ACT NON-SYSTEMICALLY (claim 1) & to NON-SYSTEMICALLY OPERATING PESTICIDE (claim 12).

There is no description in the specification for support for claimed non-systemic effects resulting from either utilizing a pesticide ADAPTED TO ACT NON-SYSTEMICALLY (claim 1) or utilizing a NON-SYSTEMICALLY OPERATING PESTICIDE (claim 12).

At page 5, lines 1-5 of the specification there is a postulated basis for no trans-dermal effects, based on excluding surfactants. It is stated that the presence of surfactants in prior art application has a potential to result in systemic effects; effects which are not intended in this invention. However, the instant claim language is to "-essentially no surfactant-" which may mean, surfactants may be present, so long as they are not essential to the function of the mixture.. The instant carrier is, according to the summary, differentiated from prior known products by essentially no surfactant present in the carrier mixture. The instant viscosity of carrier is 100-1200 SUS at 100 degrees Fahrenheit . The temperature & concentrations of carrier, pesticide & other ingredients are not claimed. Examples are to carriers of oil mixtures having unspecified additives or amounts thereof. We know not whether they are surfactant free, as carriers constitute 98+% of the total composition (see examples), but claims are simply to "essentially no

surfactant"- so other materials-volatile compounds which could include a solvent, for example, that can enhance trans-dermal penetration-are not only permitted, but in claims 11 & 19 , the unspecified volatile compounds are required.

The composition claims recite that the pesticides act non-systematically, as shown in the prior art cited, but as written the claim also permits of systemic action, Claims 1 & 12 , the independent claims, recite " __ at least one pesticide ---is adapted to act non-systemically --". The presence of another, systemically active pesticide , is not precluded.

The systemic action, or lack thereof, is recited in claim 1 as a composition of oil –based carrier(s) & a pesticide, "- wherein said pesticide is adapted to act non-systemically-".

There is no written description or any data demonstrating non-systemic efficacy, and non-systemic host effects, or of any form of adaptation of any pesticide.

We give no patentable weight of the mixture or composition, to the "wherein clause" .

This is simply a statement of what would happen as the result of application of the composition, & adds no additional limitation to the claimed composition.

The factors to be considered in determining whether a disclosure meets the enablement requirement of 38 U. S. C. 112, the first paragraph have been described in re Wands, 8 USPQ2D 1400 (Fed Cir. 1988). Among these factors are (1) the nature of the invention; (2) the state of the prior art; (3) the relative skill of those in the art; (4) the predictability or unpredictability of the art; (5) the breadth of the claims. (6) the amount of direction or guidance presented; (7) the presence or absence of working examples; and (8) the quantity of experimentation necessary. When the above factors are

weighed, it is the examiner's position that instant disclosure fails to meet the enablement requirement for the following reasons:

- (1) The nature of the invention: claims are to unqualified non-systemic effects.
- (2) The state of the prior art shows the use of these compounds with the same and similar specific carriers & pesticides.
- (3) The relative skill of those in the art is high- organophosphates are well known pesticides which can act systemically, & their use requires re-entry considerations when spraying a crop area, & blood monitoring to determine the systemic presence. .
- (4) The unpredictability of the art is very high.
- (5) The breadth of the claims. The claims are very broad, as systemic effects can not be proven to have been performed, as opposed to topical effects, unless systemic data- blood or tissue sampling, were considered. Further, there is no claimed quantification of the carrier & pesticide, & anything else present in the open language used.
- (6) The amount of direction or guidance presented. There is none; nor specific effects- the results expected are presumptive, no guidance given for determination if in fact activity was or was not operable via systemic effects.
- (7) The presence or absence of working examples. There are none showing death of pests is caused by the treatment, nor are there examples showing means of measuring viscosity after application to an animal, means of identifying whether or not systemic activity was present. There are examples of compositions which would meet the claimed viscosity of carrier, abut only prior to mixing with pesticide, not after application to the animal.

(8) The quantity of experimentation necessary is extensive- one has to show death & destruction due to some unspecified adaptation of the pesticide, by other than systemic effects.

The "- adapted pesticide-" is given no patentable weight in the recitation of the composition limitations. Examination is of the composition as an oil based carrier(s) & a pesticide. The carrier is considered as having a designated viscosity. No determination can be made to identify when such a composition does or does not contain an adapted pesticide, or how it was adapted.

Whatever applicant did to the pesticides to adapt them to non-systemic action and (claim 12) to non-systemic operation was not seen in the disclosure as filed.

Claim Rejections - 35 USC § 102

B. Claim 1, 2, 4, 5, & 9 stand rejected under 35 U.S.C. 102(b) as being anticipated by WALDSTEIN- 4176076

No patentable weight is given to future intended use of the composition.

Although no animal use is expressed, the fluids are non-carcinogenic and free of ecological damage-an answer to the problem of prior lubricant skin exposure (column 1, lines 33-38; column 2, line 68) and provide pesticidal effectiveness at ½ to 1% (column 2, lines 48-49; column 3, top). There is nothing to preclude animal use, & if so applied, the composition would constitute the instant inert oil (as of instant claim 5, there is no interaction of the oils with the additives & pesticidal borates) & "adapted" pesticide so

inherently be no-systemic.. Surfactants are common, but not required (column 5, lines 25-26). The carrier is mineral oil base (instant claim 4), of oils of 70-800 SUS (column 5, lines 11-13).

Example 1, is a mineral oil mix of 160 SUS, the same as the instant mineral oils, and meeting instant claim 9. There is no surfactant (thus meeting claim 2).

C. Claim 1, 2, 4, 5, 7, 8 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over MALLIS et al 2988473

.This old patent states that it is common practice to employ as insecticides petroleum hydrocarbon oils alone or in combination with auxiliary chemical toxicants.(col. 1, lines 14-16). Petroleum oils are stated to be well known carriers applied to livestock, to repel flies (column 1, lines 24-30). Claims 1-2 are met by Example V-oil carrier of 103 SUS is mixed with pesticidal dimethylsilicone, a non-systemic insecticidal effect results , since the pesticide & oil constitute the instant composition. The second test spray @ example V shows oil alone killed 63 % of the insects, while oil + dimethyl silicone killed all. Note there is no surfactant & the carrier is 103 SUS.

MALLIS states it is common to use auxiliary toxicants. These include those of instant claims 7 & 8, pyrethroids and pyrethrin (column 1, lines 35-41); and organophosphates-parathion (column 3, lines 63-65). The oil as described at Example 5 is considered to be the instant mineral oil, not otherwise defined in the instant claims 4 & 5.

D. Claim 1-2,5, 7-9 & 11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over COFFEE et al 4316914 as explained by centistokes to SUS conversion table (Velcon 2003).

Giving no patentable weight to future intended use, the instant composition is shown. Permethrin as an inert pesticide in a carrier in solution without a surfactant having a resultant viscosity of 1-50 centistokes is taught (column 2, lines 28-37). 50 centistokes is shown by VELCON to equate to 230 SUS, thus meeting claim 9 requiring greater than 120 S.U.S. Example 1 provides 100 SUS (21.2 centistokes), as of instant claims 1,2,5,7 & 8. Example 8 with a volatile compound- aromasol -(as in instant claim 11), and Example 9, have viscosities of 230 SUS and 190 SUS respectively (50 and 43 centistokes).

(10) Response to Argument

A. Appellants' arguments regarding the 35 USC 112 issue is addressed above.

B. Appellants' arguments regarding WALDSTEIN, in essence are that the compositions have no pesticide, particularly none adapted to act non-systemically- & they are not for use on animals, as the rust inhibitor is for ferrous surfaces. Examiner finds what is claimed is a composition, having a pesticide, Alkanolamide borates, NO essential surfactant (it's customary, but example 1 has none) & providing oils with viscosity of 160 SUS (EXAMPLE 1).

There is nothing to preclude this composition from animal use.

There is no basis for patentability based on future intended use, or on the expectation of adaptation as a function of the claimed "wherein—" clause.

C. Appellants argue MALLIS does not teach each & every element, & certainly not in as complete detail as are instantly claimed. The composition of instant claim 1 is a mixture intended to be applied to an animal, to provide barrier protection. Appellants' arguments regarding the rejection over MALLIS again address future intended use as a requirement of the claim, again not of patentable weight in examiner's

consideration of the composition claim. There is nothing claimed having any feature which provides an adaptation of the pesticide, thus the "wherein clause" is simply a statement of what would happen as the result of application of the composition, & adds no additional limitation to the claimed composition.

Appellant also argued teaching away, stating since the compositions of viscosity of 43.2 SUS was the only example applied for livestock (& thus contrary to the instant requirement of \geq or $>$ 100 SUS) the other applications are for cockroach, not found on animals. However, while this method is not that of the instant methods, there is nothing that prevents the compositions of MALLIS from being applied anywhere one would wish to, & the MALLIS compositions are the instant compositions, as claimed. See Example V. Examiner finds that since we are not examining methods of use, we find the composition, at example V, to be that of the instant, with SUS of 103, & no surfactant.

D. Appellants' arguments regarding the rejection over COFFEE are again to the effect application is not suitable for animals, as Coffee sprays plants. Also, claim 2 requires essentially no surfactant, while claim 9 requires > 120 SUS & claim 11 requires a volatile compound, all applied to animals; none of these requirements were evident to appellant to be disclosed by Coffee.

Examiner finds the no animal requirement of no patentable weight in consideration of the composition, as there is no toxicity issue precluding such use. As to the surfactant, it is not an essential feature, the various examples are of oils & pesticides, surfactant free. The Aromasol of example 8 is a volatile compound- aromatic hydrocarbons, with the composition of 50 centistokes, converted to 230 SUS @ the VELCON chart, thus > 120 SUS of claim 9.

E. Appellants' arguments regarding the rejection over LEWER to the effect that there is no teaching of Appellants viscosity range is persuasive, as there is no exemplification of a composition at the low end (100 centistokes) of the LEWER extreme range.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Art Unit: 1615

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/NEIL LEVY/

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